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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,315	06/30/2005	Yves Hatzfeld	4440-10	2418

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EXAMINER

BAGGOT, BRENDAN O

ART UNIT PAPER NUMBER

1638

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,315	<b>Applicant(s)</b> HATZFELD ET AL.	
	<b>Examiner</b> Brendan O. Baggot	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Restriction / Election***

1. The Office acknowledges the receipt of Applicant's application, filed 6/30/05.

Claims 1-7 are pending. Claims 1-7 are examined.

***Specification***

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See M.P.E.P. § 608.01. See page 10, Ln 12 of the specification for example.

***Information Disclosure Statement***

3. The IDS and references described in the letter submitted on 9/23/06 were not found attached to the letter. Please provide a copy of the references and IDS form 1449.

***Computer Readable Format Sequence***

4. The computer readable format sequence listing has been entered.

***Drawings***

5. The drawings are acceptable for examination.

**Claim Rejections - 35 U.S.C. §112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-2, 4-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1-2 provides for the use of SEQ ID NO: 1 as a regulatory sequence, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

In Claim 1, “associated” is unclear in it’s relationship to SEQ ID NO: 1. Does the Applicant mean operably linked?

In Claim 4 is unclear what is being retained in the “derived” product. Also, it is unclear whether the species described by “preferably” is intended to be a claim limitation. In Claim 5, “cells” lack antecedence. Also, the metes and bounds of consisting essentially of” are unclear as it is not defined.

In Claim 5, the recitation of “cells” lacks antecedent basis.

Claim 6 recites the limitation "a" plant. There is insufficient antecedent basis for this limitation in the claim. Applicant is required to amend the claim to recite “the” plant.

Claim 7 is an incomplete method claim in that it recites no active step and fails to achieve its stated objective.

***Claim Rejections - 35 U.S.C. §101***

7. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 U.S.C. §112, first paragraph, written description***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1(a) lacks adequate written description because SEQ ID NO: 1 is not representative of the functional variants thereof. The claims encompass mutants and allelic variants and thus imply that structural variants exist in nature, yet no structural variant has been disclosed. The claims also encompass other promoters from other species which when operably linked to a structural gene can initiate transcription. The implication is that there is a promoter

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other than that disclosed which exists in nature, but the structure thereof is not known. Applicant disclosed a single sequence SEQ NO: 1 from rice. Thus, there are insufficient relevant identifying characteristics to allow one skilled in the art to predictably determine such mutants, allelic variants and functional variants of SEQ ID NO: 1 from other plants and organisms, absent further guidance. Accordingly, there is a lack of written description to inform a skilled artisan that Applicant was in possession of the claimed invention at the time of filing. *See* The Written Description Requirement guidelines published in Federal Register/ Vol. 66, No. 4/ Friday January 5, 2001/ Notices: pp. 1099-1111.

***Claim Rejections - 35 U.S.C. §102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim1, 2 are rejected under 35 U.S.C. 102(b) as being anticipated by De Pater et al (De Pater et. al. (1992) Plant J. 2(6) 837-844). The promoter of the prior art has 97.6% sequence identity to SEQ ID NO: 1 and is identified as a rice GOS2 promoter. Accordingly the prior art promoter taught by De Pater is considered a functional variant of SEQ ID NO:1 and anticipates the claimed infection. Use claims are included because it is unclear whether Applicant intends to claim a product or a method.

***Claim Rejections - 35 U.S.C. §103***

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 1-7 are rejected under 35 U.S.C. 103(a) in view of de Pater et al (De Pater et al, Plant Journal 1992 2:6 837-44) as applied to Claim 1-2 above and further in view of Bridges et al. (6, 066, 456US, 05/2000). De Pater et al has been discussed above. de Pater et al does not teach non-monocot. Bridges et al. teaches using a monocot promoter in dicot plants. (Col. 11, Ln. 35-65). Bridges also teaches motivation for doing so: that the monocot promoter allowed for inducible expression of genes in dicot plants. (Col. 11, Ln. 35-65).

It would be *prima facie* obvious to one having ordinary skill in the art at the time of the invention was made to substitute the monocot promoter of Bridges with the promoter of De

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Pater, for the purpose of promoter expression. One skilled in the art would have been motivated to do so with a reasonable expectation of success.

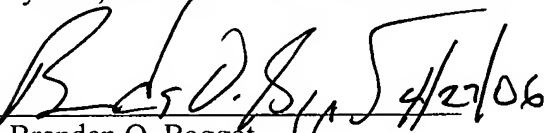
**Remarks**

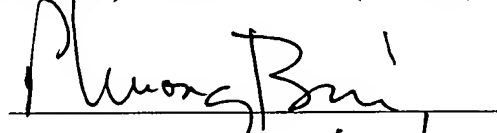
14. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brendan O. Baggot whose telephone number is 571/272-5265. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571/272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brendan O. Baggot  
Patent Examiner  
Art Unit 1638

  
4/27/06

bob

PHUONG T. BUI  
PRIMARY EXAMINER